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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,115	05/31/2001	Michael D. Apel	06005/37170	9797

4743 7590 10/11/2006

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EXAMINER

NGUYEN, TANH Q

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/871,115

Applicant(s)

APEL ET AL.

Examiner

Tanh Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-30,37-54,56-71,80 and 87-110 is/are pending in the application.
- 4a) Of the above claim(s) 37-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-30,56-71,80 and 87-110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 12-30, 56-71, 80, 87-110 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner cannot find support in applicant disclosure for the limitation "wherein the process controller implements a control routine to produce a device control signal based on one or more process parameter measurement signals, the first interface adapted to receive one or more device control signals from the process controller for the first device or to provide one or more process parameter measurements from the first device to the process controller".

Applicant is required to specifically point out the location for such support in applicant's disclosure, or remove the new matter.

### ***Response to Arguments***

3. Applicant's arguments with respect to the pending claims have been considered but are either moot in view of the new ground(s) of rejection or not persuasive.

4. Applicant submitted that the amendments do not add any new matter as the amendments are fully supported by the description of the application as originally filed.

The argument is not persuasive because the examiner cannot find support in applicant disclosure for the limitation "wherein the process controller implements a control routine to produce a device control signal based on one or more process parameter measurement signals, the first interface adapted to receive one or more device control signals from the process controller for the first device or to provide one or more process parameter measurements from the first device to the process controller". Applicant is required to specifically point out the location for such support in applicant's disclosure to support the amendments.

5. Applicant further argued the followings:

*As known by those skilled in the art, a process controller, as recited by the pending claims, provides continuous (e.g., periodic) control of one or more field devices coupled to the process controller to maintain the process in a desired state using the field device. To maintain the field device, process parameter measurement signals from one or more field devices coupled to the process controller can be used by the process controller to generate control signals to be delivered to the one or more field devices. In other words, the process controller of the claimed method and system implements a control routine to produce a device control signal based on one or more process parameter measurement signals.*

*As further known by those skilled in the art, a process controller may communicate with a plant network system to provide information about operations under the process controller's management (e.g., field device operation) and to receive setpoint signals that are used in adjusting the operation of a process controller. However, as also known by those skilled in the art, a plant network system is not a process controller. Specifically, the plant network does not provide a device control*

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*signal intended for a particular field device. While a device on the plant network may provide, in some instances, a setpoint signal to a process controller to adjust the operation of a process controller, a setpoint is distinct from a control signal because a control signal is based on and developed from at least a process parameter measurement signal.*

*Furthermore, I/O devices on the network are not process controllers, as known by those skilled in the art and as recited by the pending claims, because I/O devices do not generate a control signal based on process parameter measurement signals. While I/O devices may translate signals between different communication links, for example, between one or more bus protocols, I/O devices do not calculate a control signal based on process parameter measurement signals.*

By the above arguments, it appears that applicant relied on "known by those skilled in the art" statements to support the amendments to the claims. The arguments are not persuasive for the following reasons:

First, it is noted that the process parameter measurement signals from one or more of the field devices **do not have** to be used by the controller to generate control signals - as applicant already admitted (**can be used**). Since applicant has not **explicitly** established that process parameter measurement signals from one or more field devices coupled to the process controller **must be used** by the process controller to generate control signals to be delivered to the one or more field devices, applicant has not reasonably conveyed to one skilled in the art at the time the invention was filed that applicant has possession of the claimed invention.

Second, it is noted that even affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660,

18 USPQ2d 1331 (Fed. Cir. 1991); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

6. Applicant may file a continuation-in-part to incorporate the limitation “wherein the process controller implements a control routine to produce a device control signal based on one or more process parameter measurement signals, the first interface adapted to receive one or more device control signals from the process controller for the first device or to provide one or more process parameter measurements from the first device to the process controller”, or amend the claims without incorporation of new matter and with languages that patentably distinguish the claims from the references.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

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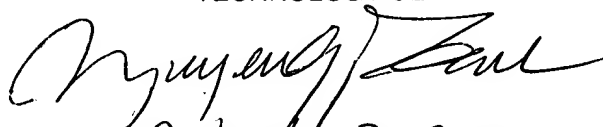
than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TANH Q NGUYEN  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100



September 30, 2006

TQN  
September 30, 2006